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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/401,939	09/23/1999	MICHAEL C. SCOGGIE	CAT/29US-SCROCO	5333

31518   7590   06/29/2005

NEIFELD IP LAW, PC
4813-B EISENHOWER AVENUE
ALEXANDRIA, VA 22304

EXAMINER
JANVIER, JEAN D

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)
Office Action Summary	●	09/401,939 ●	SCOGGIE ET AL.
		Examiner	**Art Unit**	
		Jean Janvier	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *32-70* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *32-70* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application

after a decision by the Board of Patent Appeals and Interferences, but before the filing of a

Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil

action. Since this application is eligible for continued examination under 37 CFR 1.114 and the

fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to

37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114.

Applicant's submission filed on 04/07/05 has been entered and an Action follows.

Response To Applicant's Arguments

All potential arguments are moot in view of new grounds of rejection.

Terminal Disclaimers

The Office approved the Terminal Disclaimers recorded on 1/24/05 and 6/21/05.

DETAILED ACTION

Specification

Claims Status

Claims 32-70 are currently pending in the Instant Application

Claim Objections

Claims 32, 45 and 58 are objected to because of the following:

Concerning claims 32, 45 and 58, in the limitations "generating token data depending on said selection data", the term "token" defines coupon offers preferably in coded form, such as bar codes, but the token is not immediately recognized as a coupon per se (although it has coupon data encoded thereon). Subsequently, the token is transmitted to the user or user's computer and the user takes the token to his selected store, encoded on the token, and receives, upon purchasing the required item as encoded on the token, the appropriate purchase incentive or discount or promotion automatically or a voucher, redeemable on a future purchase, may be provided to the user instead and in accordance with the purchase incentive or promotion received from the central computer database and stored in the local store server database (See embodiments of figs. 13 and 18 of the specification). In other words, the token, which can very well be a piece of paper, has data similar to coupon data encoded thereon except for the discount value or the purchase incentive itself that is stored locally at the redemption site or on a remote central repository accessible by the redemption site system. In any event, whether a token or a coupon (e-coupon) is being presented for use, the redemption is virtually or substantially performed the same way, especially if the coupon distribution and redemption are conducted electronically.

Finally, "generating a purchase incentive based..." is interpreted as --retrieving the purchase incentive from the local store server in response to the token bearer's or identified user's purchase of the required item as read from the token--. Here, the "purchase incentive" was earlier transmitted from the main computer central repository to the selected local store server database in response to the user's selection.

Appropriate correction is required.

Double Patenting Rejection

The non-statutory double patenting rejection is based on a judicially created doctrine

grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA

1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

> A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to
> overcome an actual or provisional rejection based on a nonstatutory double patenting ground
> provided the conflicting application or patent is shown to be commonly owned with this
> application. See 37 CFR 1.130(b).
> Effective January 1, 1994, a registered attorney or agent of record may sign a terminal
> disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37
> CFR 3.73(b).

Claims 32, 45 and 58 (i.e. 32-70) of the Instant Application are provisionally rejected

under the judicially created doctrine of obviousness-type double patenting as being unpatentable

over at least claims 65 and 67 of co-pending Application Serial No. 09/478,351. Although the

conflicting claims are not identical, they are not patentably distinct from each other because of

the following reasons:

Claim 32 of the Application substantially recites the limitations of claim 65 of

Application Serial No. 09/478, 351, as shown.

32. (Once Amended) A computer implemented method for distributing
purchasing incentives to consumers, comprising:

transmitting promotion data identifying a plurality of product discounts

from a main computer to a personal computer over a computer network;

displaying said plurality of product discounts at said personal computer

based on said promotion data;

transmitting selection data designating at least one product discount

selected from said plurality of product discounts from said personal computer to

said main computer over said computer network;

generating token data depending on said selection data;

transmitting said token data from said main computer to said personal

computer over said computer network;

identifying said token data in a retail store in association with items being

purchased at said retail store;

determining discount items being purchased corresponding to said at least

one product discount from said identified token data; and

generating a purchase incentive based on said discount items.

65. (Twice Amended) A method for distributing purchasing incentives to customers,

said method comprising [the steps of]:

transmitting a prompt for an electronic [mailing] mail address of a customer from

a central computer over a computer network to a personal computer;

in response to said prompt, transmitting said electronic [mailing] mail address over said computer network to said central computer;

associating at [the] said central computer the electronic [mailing] mail address with a unique customer identification;

transmitting an incentive offer over said computer network to said personal computer based on data stored at the central computer and associated with the unique customer identification;

transmitting incentive offer selection data over said computer network to said central computer; and

in response to said selection data, transmitting data defining an incentive token over said computer network to said personal computer, wherein said incentive token is exercisable for said

incentive at a store designated by said incentive offer.

As shown above, claim 32 omits the underlined portions of claim 65. However, one skilled in the art would have understood that these underlined portions or limitations are implicitly recited in claim 32. Further, this mailing address (including zip code) is part of the demographic data originally collected from the user during the initial encounter (user's first contact with the system) to decide, for example, whether or not the user lives in a qualified zip code, i.e. a zip code associated with a participating local store, before the user is allowed to receive and select product offers therefrom. In other words, before the user is allowed to select products from the system, as recited in claim 32, he must first provide his mailing address (at

least his zip code) and this mailing address can be used at least to transmit the generated token,

samples or marketing literature, to the user.

Additionally, it is common practice to collect demographic information including mailing

address from a user and use the collected information to send, via the Post Office, promotional

information, such as coupons, to the user.

Therefore, an ordinary skilled artisan would have been motivated at the time of the

invention to collect demographic information, including mailing address having a defined zip

code, from the user during a registration process and use the collected data to decide whether the

user lives in a qualified zip code and to mail, subsequent to this determination, a product coupon

or a generated token having encoded thereon the user's product offer selections.

This is a <u>provisional</u> obviousness-type double patenting rejection since the conflicting

claims have not in fact been patented.

Claims 32, 45 and 58 (i.e. 32-70) of the Instant Application are rejected under the

judicially created doctrine of obviousness-type double patenting as being unpatentable over

claims 7 and 8 of U.S. Patent No. 6, 185, 541. Although the conflicting claims are not identical,

they are not patentably distinct from each other.

For example, claim 32 of the Instant Application substantially recites the limitations of

claim 8 of the Patent, as shown below.

32. (Once Amended) A computer implemented method for distributing purchasing incentives to consumers, comprising:

transmitting promotion data identifying a plurality of product discounts from a main computer to a personal computer over a computer network;

displaying said plurality of product discounts at said personal computer based on said promotion data;

transmitting selection data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network;

generating token data depending on said selection data;

transmitting said token data from said main computer to said personal computer over said computer network;

identifying said token data in a retail store in association with items being purchased at said retail store;

determining discount items being purchased corresponding to said at least one product discount from said identified token data; and

generating a purchase incentive based on said discount items.

8. A method for distributing purchasing incentives to customers, said method comprising the steps of:

<u>transmitting a prompt for **identity data** from a central computer over a computer network to a personal computer;</u>

<u>in response to said prompt, transmitting said identity data over said computer network to said central computer;</u>

transmitting an incentive offer over said computer network to said personal computer;

transmitting incentive offer selection data over said computer network to said central computer; and

in response to said selection data, transmitting data defining an incentive token over said computer network to said personal computer, wherein said incentive token is exercisable for said

incentive at a store designated by said incentive offer, **further comprising transmitting terms of said purchasing incentive to an in-store server computer.**

As shown above, claim 32 omits the underlined portions of claim 8. However, one skilled in the art would have understood that these underlined portions or limitations are implicitly recited in claim 32. Further, this mailing address or identity data (including zip code) is part of the demographic data originally collected from the user during the initial encounter (user's first contact with the system) to decide, for example, whether or not the user lives in a qualified zip code, i.e. a zip code associated with a participating local store, before the user is allowed to receive and select product offers therefrom. In other words, before the user is allowed to select products from the system, as recited in claim 32, he must first provide his mailing address (at least his zip code) and this mailing address can be used at least to transmit the generated token, samples or marketing literature, to the user. It is further recognized, broadly interpreted, that the user's registration data are used, among other things, to create an ID or code or Password or identity data for the user and the user uses this cod (identity data) to log into the system and select coupon or product or incentive offers therefrom.

Additionally, it is common practice to collect demographic information including mailing address from a user and use the collected information to send, via the Post Office, promotional information, such as coupons, to the user. Finally, using a password or identity data to log into a remote server or central computer is well documented in the art.

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to collect demographic information, including mailing address having a defined zip code, from the user during a registration process and use the collected data to decide whether the user lives in a qualified zip code, to generate a code (identity data) or password for the user and to mail, subsequent to this determination, a product coupon or a generated token having encoded thereon the user's product offer selections made online at the main computer using his generated password or code or identity data to log into the main computer.

Here, Applicant can amend the conflicting claims of the Instant Application or file a Terminal Disclaimer to overcome the Obviousness Double Patenting Rejection.

Conclusion

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719

06/34/05   **Jean D. Janvier**

JDJ   Patent Examiner

                                                                          Art Unit 3622

JEAN D. JANVIER
PRIMARY EXAMINER